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DANIEL J SWIRSKY			EXAMINER	
55 REUVEN ST.			SKOLER, JAY R	
BET SHEMESHI, 99544				
ISRAEL			ART UNIT	PAPER NUMBER
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			03/10/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,229

Applicant(s)

PAZ, ADRIAN

Examiner

JAY R. SIGLER

Art Unit

3775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-34, 36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-34, 36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. It is noted that applicant has not filed a certified copy of the 0324830.9 and 0315479.6 applications as required by 35 U.S.C. 119(b).

Specification

2. Claim 34 and 37 are objected to because of the following informalities: in claim 34, line 7, "realising" appears to be a typographical error; and in claim 37, line 24, the language "said controlling means bein" contains a typo. Appropriate correction is required. The said language will be considered "said controlling means being" and "releasing", respectively, for further examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 33 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The language "suturing means;... drilling means,

resecting means, dissecting means, coagulating means, fixating means, ablative means" is not supported by the originally filed disclosure. It is noted that embodiments or species of these means may be disclosed, but they are not sufficient support for the entire genus of the claimed means.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 29-34, 36, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. Concerning claim 29-34, and 36: the language "said surgical instrument holding device" (claim 29, l. 5-6 and 8-9) lacks proper antecedent basis in the claim.

The language "said holding device" (claim 31, l. 2-3) lacks proper antecedent basis in the claim.

The language "said surgical instrument attached to said second anchoring means" (claim 33, l. 7-8) renders the claim indefinite. Claim 29 is drawn to the subcombination of a surgery-assisting anchoring device while only functionally reciting the surgical instrument, i.e. "A surgery-assisting anchoring device... comprising... second anchoring means... adapted for attaching at least one surgical instrument...", but claim 33 is drawn to the combination by positively reciting the surgical instrument as part of the claimed invention. Therefore, it is unclear which invention is being claimed, i.e. the combination or subcombination.

The language "additionally comprising a... a vacuum cup attached to said at least one surgical instrument" (claim 34) renders the claims indefinite. Claim 29 is drawn to the subcombination of a surgery-assisting anchoring device while only functionally reciting the surgical instrument, i.e. "A surgery-assisting anchoring device... comprising... second anchoring means... adapted for attaching at least one surgical instrument...", but claim 33 is drawn to the combination by positively reciting the surgical instrument as part of the claimed invention. Therefor, it is unclear which invention is being claimed, i.e. the combination or subcombination.

In claim 36, "and/or" is indefinite because it is unclear what limitation such language places on the claimed subject matter.

b. Concerning claim 37, the language "said surgical instrument holding device" (l. 9-10 and 16-17) lacks proper antecedent basis in the claim. The language "said surgical instrument holding" (l. 18-19 and 20-21) lacks proper antecedent basis in the claim. The language "may be" (l. 18) is indefinite because it is unclear what limitation such language places on the claimed subject matter. The language "the operator" (line 25) lacks proper antecedent basis in the claim.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 37 is rejected under 35 U.S.C. 101 because it is drawn to non-statutory subject matter. In lines 24-25, applicant positively recites part of a human, i.e. "said controlling means being at least partially operated by the operator from outside the body". Thus, claim 37 includes a human within its scope and is non-statutory.

A claim directed to or including within its scope a human is not considered to be patentable subject matter under 35 U.S.C. 101. The grant of a limited, but exclusive property right in a human being is prohibited by the Constitution. *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970).

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 29-35 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by US 2003/0009080 to Peng et al. (hereinafter "Peng").

- c. Concerning claim 29: Peng discloses connected first anchoring means 1 and second anchoring means 3, said first attaching means for attaching the device to an internal surface within a cavity of the human body and said second attaching means for attaching to surgical instruments or devices within said cavity (see Fig. 1). The device of Peng is capable of being introduced entirely into a cavity.
- d. Concerning claims 30-35 and 37: Peng further discloses a vacuum means 1; suction flow regulator 6 (vacuum release means/means allowing the holding device to be moved or controlling means); vacuum accumulator 7 (vacuum application means); the vacuum cup can be considered attached to the surgical instrument through element 40; and surgical instrument 8 which is a retracting means.

With regard to any statement of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Peng which is capable of being used as claimed if one so desires to do so. In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the

claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Peng.

Peng discloses the claimed invention but not specifically including a timer means. Timers were known in the art at the time of the invention for allowing a function to run for a predetermined time period. It would have been obvious to someone of ordinary skill in the art at the time of the invention to have a timer in the invention of Peng in order to allow the suction of the vacuum to run for a predetermined time period

It is noted that the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant failed to traverse the examiner's assertion of official notice.

Response to Arguments

13. Applicant's arguments filed 29 December 2008 have been fully considered but they are not persuasive.

14. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

15. Further, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

16. Further, a reference may be from an entirely different field of endeavor than that of the claimed invention or may be directed to an entirely different problem from the one addressed by the inventor, yet the reference will still anticipate if it explicitly or inherently discloses every limitation recited in the claims. (*In Re Schreiber*, 44 USPQ2d 1429).

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAY R. SIGLER whose telephone number is (571)270-3647. The examiner can normally be reached on Monday through Thursday from 8 AM to 4 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. R. S./
Examiner, Art Unit 3775
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733